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Our Ref.: 4380-105
Your Ref.: 10/014,797 Date: May 10, 2007

To: Commissioner for Patents c/o Examiner AFREMOVA
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From: Willem F. Gadiano

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ATTACHMENT/S: |

1. Transmittal of Appeal Brief (2 pages);
2. APPEAL BRIEF (10 pages).

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Date:

By:

William F. Gadiano, Registration No. 37,138

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of

Steven M. BESSETTE

Atty. Ref.: WFG-4380-105; Confirmation No. 1638

Appl. No. 10/014,797

TC/A.U. 1651

Filed: December 14, 2001

Examiner: Afremova, Vera

For: PESTICIDAL COMPOSITIONS CONTAINING ROSEMARY OIL AND
WINTERGREEN OIL

* * * * *

TRANSMITTAL OF APPEAL BRIEFHonorable Commissioner for Patents
Mail Stop Appeal Brief-Patents

Sir:

Submitted herewith is Appellant(s) Appeal Brief in support of the Notice of Appeal filed October 10, 2006. Please grant any extension of time not previously paid for, if needed. Please charge the Appeal Brief to Deposit Account 14-1140 (please use reference number: WFG-4380-105) or credit any overpayment of fees to such Deposit Account.

1204133

Steven M. BESSETTE
Appl. No. 10/014,797

Atty. Docket No. WFG-4380-105

To the extent necessary, please grant any further extension of time under 37 C.F.R.
1.136 deemed necessary. Please charge any shortage in fees due, or any excess fees paid,
to Deposit Account 14-1140 (please use reference number: WFG-4380-105).

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Willem F. Gadiano

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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WINTERGREEN OIL

* * * * *

APPEAL BRIEF

Mail Stop Appeal Brief-Patents
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellant herein appeals from the Examiner's final rejection of the pending claims. Appeal is timely and proper pursuant to 37 CFR § 1.191(a). This Appeal Brief is submitted in support of the Notice of Appeal filed October 10, 2006.

1204117

Steven M. BESSETTE
Appl. No. 10/014,797

Atty. Docket No. 4380-105

REAL PARTY IN INTEREST

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This application is assigned to EcoSmart Technologies, Inc., by assignment recorded on July 11, 2002, at Reel 013087, Frame 0792.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 1, 7, 17, 20 and 140-145 are pending. Claims 2-6, 8-16, 18, 19, and 21-139 have been canceled without prejudice or disclaimer of the subject matter they contain. A copy of the pending claims is found in APPENDIX A attached hereto.

STATUS OF AMENDMENTS

It is believed that all amendments filed in this case before May 10, 2005, have been entered.

SUMMARY OF INVENTION

The presently claimed invention is directed to pesticidal compositions comprising a pesticidally acceptable carrier and a pesticidally active ingredient, wherein the pesticidally active ingredient consists of rosemary oil and wintergreen oil.

ISSUES

1. Should the currently pending claims remain rejected under 35 U.S.C. §§ 112, second paragraph, as allegedly being indefinite?

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2. Should the currently pending claims remain rejected under 35 U.S.C. §§ 112, first paragraph, as allegedly failing to comply with the written description requirement?

3. Should the currently pending claims remain rejected under 35 U.S.C. §§ 102(b) and 103(a), as allegedly being anticipated by DE 524 383 in view of Merck (Encyclopedia of Chemicals, Drugs and Biologicals. 1996)?

4. Should the currently pending claims remain rejected under 35 U.S.C. §§ 103(a), as allegedly being unpatentable over DE 524 383 taken with Merck, the references of Inazuka et al. (1982a), Watanabe et al., U.S. 4,379,168 (Dotolo), U.S. 6,004,569 (Bessette et al.) and U.S. 5,496,857 (Targosz)?

GROUPING OF CLAIMS

Under 35 U.S.C. § 282, Appellant submits that the patentability of each appealed claim is not solely predicated on the patentability of the remaining appealed claim(s). Each claim of this patent application is separately patentable and upon issuance of a patent will be entitled to a separate presumption of validity. Pursuant to 37 C.F.R. § 1.192(5), each pending claim(s) will separately stand or fall in this appeal.

THE ARGUMENT

Appellant's responses to each of the rejections raised in the final Office Action against the currently pending claims (1) are set forth in previously filed responses, *ad nauseum*, and (2) are incorporated herein by reference in their entirety. Reconsideration and reversal of the pending rejections are respectfully requested in view of same.

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REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Examiner asserts that claims 1, 7, 17, 20 and 141 - 145 recite the use of "inert carrier" and that dependent claims recite that "inert" carriers are mineral oil, benzyl alcohol, citronellal, limonene, safflower oil, soybean oil, and sesame oil (claims 7, 17, 20, 141 - 145). The Examiner asserts that Appellant's definitions of "inert carrier" are confusing and indefinite. The Examiner asserts:

At one instance... the term "inert" carrier as materials that facilitate application of active components (page 16, lines 26-30). The list of inert carriers includes generic alcohols and generic "botanical oils" including soy oil and some "light oils" (page 17, lines 8, 11 and 15). However, at the other instance Appellant defines botanical oils or plant essential oils as active ingredients having pesticidal effects... The pesticidally active essential oils or botanical oils (page 12, line 26) include benzyl alcohol (page 12, line 32), citronellal, limonene, safflower or "starflower" oil, soybean oil, and sesame oil (page 13, lines 3, 18, 34). The disclosed list of pesticidally active oils also include mineral oil (page 13, line 23). Thus, the same compounds are regarded by Applicant as both active and inert materials. Therefore, the... definitions of "inert" materials and of pesticidally "active" materials are at the very least very confusing and, thus, indefinite.

In response, Appellant urges that one of skill in the art could readily understand the meaning of the rejected term. In rejecting a claim under the second paragraph of 35 U.S.C. § 112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *In re Wu*, 10 U.S.P.Q.2d 2031, 2033 (Bd. Pat. App. & Int. 1989). Here it is believed that the Examiner has not satisfied this burden because the claims in fact set out and circumscribe a particular area with a reasonable degree of precision and particularity. The definiteness of the rejected language must be analyzed--not in a vacuum, but always in light

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of the teachings of the prior art and of the particular application disclosure as it would be interpreted by the ordinarily level of skill in the pertinent art. *In re Moore*, 439 F.2d 1232, 1235, 169 U.S.P.Q. 236, 238 (C.C.P.A. 1971). See also *In re Watson*, 517 F.2d 465, 186 U.S.P.Q. 11, 20 (C.C.P.A. 1975) (stating that claim language must be read in light of the application disclosure as it would be interpreted by one of ordinary skill in the art). Further, as exemplified by the Federal Circuit in *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987), quoting from *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed. Cir. 1985): [I]f the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention and if the language is as precise as the subject matter permits, the courts can demand no more. As such, Appellant respectfully requests reversal of the Examiner and withdrawal of this rejection.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner has also rejected claims 7, 17, 20 and 140-145 under 35 U.S.C. 112, first paragraph, as allegedly failing to comply with the written description requirement. The Examiner asserts that the claim(s) contain(s) subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner asserts that insertion of the limitation drawn to a pesticidal composition that "consists of only 3 ingredients that are rosemary oil, wintergreen oil and only one "inert" ingredient that is either mineral oil or benzyl alcohol or citronella¹ or limonene or safflower oil or soybean oil or sesame oil allegedly has no support in the as-filed specification and is a new concept because it neither has literal support in the as-filed specification by way of generic

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disclosure, nor are there specific examples of the newly limited compositions that would show possession of the concept of the use of only 3 ingredients in the pesticidal composition.

Appellant respectfully submits that the court in *In re Wertheim*, 646 F.2d 527, 191 U.S.P.Q. 90, 96 (C.C.P.A. 1976) stated: "... [an] application need not describe claim limitations exactly, but only so clearly that person of ordinary skill in art will recognize from disclosure that Appellant invented processes including those limitations." The fundamental issue is whether the additional material was inherently contained in the original application. See *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 221 U.S.P.Q. 97 (Fed. Cir. 1984). The test for claim support under the first paragraph of Section 112 is whether the disclosure as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support. *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 227 U.S.P.Q. 177 (Fed. Cir. 1985). Indeed, at page 12, line 21, the specification states that pesticidal composition comprises rosemary oil and wintergreen oil with a suitable carrier and optionally with a suitable surface active agent, **with and without** one or more additional essential oil compounds and derivatives thereof, natural or synthetic, including racemic mixtures, enantiomers, diastereomers, hydrates, salts, solvates and metabolites, etc. As such, Appellant respectfully requests reversal of the Examiner and withdrawal of this rejection.

REJECTION UNDER 35 U.S.C. § 102

The Examiner also rejected claims 1, 7, 17, 20, 141 and 142, as amended, under 35 U.S.C. § 102(b), as allegedly being anticipated by DE 524 383 in view of Merck (Encyclopedia of Chemicals, Drugs and Biologicals. 1996). In response, Appellant respectfully submits that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention. *The Kegel Co. v. AMF Bowling*, 127

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F.3d 1420, 44 USPQ2d 1123 (Fed. Cir. 1997); *Gechter v. Davidson*, 116 F.3d 1454, 43 USPQ2d 1030 (Fed. Cir. 1997). DE 524 383 discloses that rosemary oil and wintergreen oil are mixed with several other oils, such as linseed oil, anisole, turpentine oil, lemon oil, etc., to obtain a composition for combating cockroaches, bugs, etc. DE 524 383, however, does not disclose a pesticidal composition having the specific combination of features required by the claimed invention. In particular, neither DE 524 383 (nor Merck) teach a pesticidal composition consisting of an inert carrier and a pesticidally active ingredient, wherein the pesticidally active ingredient consists of rosemary oil and wintergreen oil. Indeed, there are significant differences between the presently claimed invention and the presently claimed invention within the meaning of 35 U.S.C. §102. Thus, Appellant respectfully requests reversal of the Examiner and withdrawal of this rejection.

REJECTION UNDER 35 U.S.C. § 103

Further, the Examiner rejects claims 1, 7, 17, 20 and 140-145 under 35 U.S.C. § 103(a), as allegedly being unpatentable over DE 524 383 taken with Merck, the references of Inazuka et al. (1982a), Watanabe et al., U.S. 4,379,168 (Dotolo), U.S. 6,004,569 (Besette et al.) and U.S. 5,496,857 (Targosz). The Examiner asserts that the cited documents disclose the use of various carriers or diluents in pesticidal compositions including mineral oil (DE 524 383) or citronellal (Watanabe et al.) or limonene and citronellal as components of lemon oil (DE 524 383 in view of Merck). Because these references do not teach the use of pesticidally acceptable carriers such as benzyl alcohol, safflower oil, soybean oil and sesame oil, the Office Action apparently relies on U.S. Patent No. 5,496,857 for teaching safflower oil, soybean oil, sesame oil and also mineral oil as components in pesticidal mixtures; U.S. Patent No. 4,379,168 for teaching benzyl alcohol and citronellal as components of pesticidal mixtures; and U.S. Pat. No. 6,004,569 for teaching

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the use of d-limonene as a component of pesticidal mixtures. Appellant respectfully traverses this rejection.

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In response, Appellant respectfully submits that it would not have been obvious to one having ordinary skill in the art reading the cited references at the time the claimed invention was made to add or to substitute any one of purported carrier(s) into the composition of the cited DE 524 383 to arrive at the presently claimed invention. None of the remaining cited references remedy the deficiencies of DE 524 383 by teaching or suggesting a pesticidal composition consisting of an inert carrier and an active ingredient, wherein the active ingredient consists of rosemary oil and wintergreen oil. DE 524 383 does not provide any suggestion or motivation to remove ingredients in the disclosed composition to arrive at the presently claimed invention. Moreover, the cited references teach compositions having components that are synergistic diluents, not inert carriers, as presently claimed. Thus, Appellant respectfully requests reversal of the Examiner and withdrawal of this rejection.

CONCLUSION

In view of the foregoing, Appellant submits that there exists no factual basis to support a conclusion that the present claimed subject matter fails to satisfy the requirements of 35 U.S.C. §§ 112 (first and second paragraphs), 102(b) or 103(a) in view of the prior art applied in the final Office Action. It is respectfully submitted that the rejection of the claims on appeal is in error and should be reversed.

To the extent necessary, a petition for an extension of time under 37 CFR 1.136 is hereby made. The Commissioner is hereby authorized to charge any deficiency in the small-entity fee(s)

Steven M. BESSETTE
Appl. No. 10/014,797

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filed, or asserted to be filed, or which should have been filed herewith (or with any paper filed hereafter) to Deposit Account No. 14-1140 (please use reference no. WFG-4380.0105).

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: 

Willem F. Gadiano

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APPENDIX A

1. A pesticidal composition consisting of an inert carrier and a pesticidally active ingredient, wherein the pesticidally active ingredient consists of rosemary oil and wintergreen oil.

Claims 2-6 (CANCELED)

7. The pesticidal composition of claim 1, wherein the inert carrier is selected from the group consisting of mineral oil, benzyl alcohol, citronellal, d-limonene, safflower oil, soybean oil, and sesame oil.

Claims 8-16 (CANCELED)

17. The pesticidal composition of claim 1, wherein rosemary oil and wintergreen oil are present in equal amounts.

Claims 18-19 (CANCELED)

20. The pesticidal composition of claim 7, wherein the inert carrier is mineral oil.

Claims 21-139 (CANCELED)

140. The pesticidal composition of claim 7, wherein the inert carrier is benzyl alcohol.

141. The pesticidal composition of claim 7, wherein the inert carrier is citronellal.

142. The pesticidal composition of claim 7, wherein the inert carrier is d-limonene.

143. The pesticidal composition of claim 7, wherein the inert carrier is safflower oil.

144. The pesticidal composition of claim 7, wherein the inert carrier is soybean oil.

145. The pesticidal composition of claim 7, wherein the inert carrier is sesame oil.